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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,050	07/07/2003	Hiroyoshi Tagi	56937-081	4706
7590	03/07/2006			EXAMINER SEMENENKO, YURIY
McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			ART UNIT 2841	PAPER NUMBER

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,050	TAGI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yuriy Semenenko	2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 19 January 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1 and 4-24 is/are pending in the application.
- 4a) Of the above claim(s) 6-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 4 and 5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

1. Amendment filed on 1/19/2006 has been entered.

In response to the Office Action dated 10/19/ 2005, Applicants has amended claims 1, 4 and 5.

Claims 2 and 3 has been cancelled. Claims 6-24 had been withdrawn from consideration.

Claims 1 and 4-24 are now pending in the application.

### ***Drawings***

2. The Drawings amendments, filed on 1/19/2006 are considered and is acknowledged. The Drawings amendments are approved. The objection to the Drawings have been withdrawn.

### ***Claims***

3. Claims 4 and 5 amendments, filed on 1/19/2006 are considered and is acknowledged. The claims amendments are approved. The objection to the claims have been withdrawn.

### ***Response to Arguments***

4. Applicant's arguments filed 1/19/2006 have been fully considered but they are not persuasive.

4.1. Applicant asserts that Jones does not disclose "the auxiliary lead is not in electrical contact with the signal transmitting lead". But APA discloses this limitation in Fig. 7: a printed wiring board 801, Fig.1 comprising an auxiliary lead 804 which is provided on the insulating board 803 while the auxiliary lead 804 is not in electrical contact with the signal transmitting lead 805, please see Fig. 7 and Specification, page 2, lines 13-21.

4.2. Applicant asserts that Jones does not disclose "the electromagnetic shielding layer is made of a magnetic material having magnetic loss. Joens discloses shielding layer. But APA discloses this limitation "the electromagnetic shielding layer 806" on page 2, lines 24-27 of the Specification. And more, Joens discloses shielding metallic layer (component) 24, Fig.2, which implicitly can be the electromagnetic shielding layer.

4.3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5.1. Claim 1 is rejected under 35U.S.C. 103(a) as being obvious over Admitted by Applicant (Prior Art, hereinafter "APA") in view of Hayashi (Patent # 6359235) hereinafter "Hayashi" and view of Jones (Patent #5227583) hereinafter "Jones".

As to claim 1: APA discloses in Fig. 7 a printed wiring board 801 comprising: an insulating board 803 which includes a plurality of electrically insulating layers which are laminated; a signal transmitting lead 805 which is provided at an interlayer between the electrically insulating layers, Fig. 7; an auxiliary lead 804 which is provided on the insulating board while the auxiliary lead is not in electrical contact with the signal transmitting lead; and an electromagnetic shielding layer 806 made of a magnetic material having magnetic loss (Specification, page 2, lines 24-27), wherein a signal is not carried to the auxiliary lead.

except, APA doesn't explicitly teach an electronic component which is built in the insulating board .

Hayashi teaches an electronic component which is built in the insulating board. Therefore, at time the invention was made, it was well known to use an electronic component which is built in the insulating board.

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made for APA to include in his invention an electronic component which is built in the insulating board.

Benefit of doing so is to further miniaturization of the printed wiring board (PWB).

APA, also, fail to expressly disclose the electromagnetic shielding layer which covers at least a part of the auxiliary lead.

Jones teaches the shielding layer 28, Fig. 2, which covers at least a part of the auxiliary lead 26 (column 5, lines 54-57).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made for APA to include in his invention the electromagnetic shielding layer which covers at least a part of the auxiliary lead to reduce noise during transmitting high-frequency signal, which is common practice for HF technology. The prior art itself and in combinations with each other define the structure (APA, as modified, discloses the printed wiring board) is capable of performing the intended use (transmitting a high-frequency signal, as claimed claim 1), then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) AND *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 4: Further, APA, as modified, discloses the printed wiring board having all of the claimed features as discussed above with respect claim 1,

except, APA, does not teach an insulating film is provided between the auxiliary lead and the electromagnetic shielding layer.

Jones teaches an insulating film 30, Fig. 2 is provided between the auxiliary lead 26 and the electromagnetic shielding layer 28. (column 5, lines 57-59). Therefore, at time the invention was made, it was well known to use an insulating film is provided between the auxiliary lead and the electromagnetic shielding layer.

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made for APA to include in his invention an insulating film is provided between the auxiliary lead and the electromagnetic shielding layer.

Benefit of doing so is to provide better electromagnetic shield by separation of the two circuits.

As to claim 5: Further, APA, as modified, discloses the printed wiring board having all of the claimed features as discussed above with respect claim 1,

except, APA, does not teach the signal transmitting lead has lead regions which are opposite to each other, and the auxiliary lead is provided between the opposite lead regions.

Jones teaches the signal transmitting lead 36, Fig. 1 has lead regions 38 which are opposite to each other, and the auxiliary lead 26 is provided between the opposite lead regions.

Therefore, at time the invention was made, it was well known to use the signal transmitting lead which has lead regions which are opposite to each other, and the auxiliary lead is provided between the opposite lead regions.

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made for APA to include in his invention the signal transmitting lead has lead regions which are opposite to each other, and the auxiliary lead is provided between the opposite lead regions.

Benefit of doing so is to prevent a degradation of the transmitted signals.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7.1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuriy Semenenko whose telephone number is (571) 272-6106. The examiner can normally be reached on 8:30am - 5:00pm.

7.2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571)- 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7.3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YS



K. Cuneo  
30E 2841